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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/898,921	07/23/1997	YOICHI YAMAGISHI	35.C9583-CI.	6547

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NEW YORK, NY 10112

EXAMINER

NGUYEN, LUONG TRUNG

ART UNIT	PAPER NUMBER
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2612

27

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/898,921

Applicant(s)

YAMAGISHI, YOICHI

Examiner

LUONG T NGUYEN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27,29,33-35 and 37-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27,29,33-35 and 37-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 23. 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/30/2003 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 27, 29, 33-35, 37-61 and newly added claims 62-63 filed on 8/4/2003 have been considered but are moot in view of the new ground(s) of rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 44-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 9-25 of U.S. Patent No. 6,483,539 in view of Bullock et al. (US 5,675,358) further in view of Yamagishi (US 5,857,059).

Regarding claim 44, Claim 9 of U.S. Patent No. 6,483,539 discloses an external pickup apparatus connectable to an image pickup apparatus comprising a connection detector adapted to detect whether or not said image pickup apparatus is connected (a connection detector, Lines 3-4); a controller adapted to switch between a mode for reading out an image pickup program for controlling said image pickup apparatus from a program storage portion to store the image pickup program into a predetermined memory, and a mode other than the mode for reading out the image pickup program (a controller, Lines 5-10).

Claim 9 of U.S. Patent No. 6,483,539 fail to specifically disclose an interface; and an information processing apparatus adapted to be connected with said image pickup apparatus via said interface. However, Bullock et al. disclose (Figures 1 and 2) camera 118 (image pickup apparatus) is connected to computer 100 (an information processing apparatus) by means of tether 117 (interface). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Claim 9 of U.S. Patent No. 6,483,539 by the teaching of Bullock et al. in order to provide a simple, intuitive, object-oriented user interface to control an image capture device Column 1, Lines 43-45).

Claim 9 of U.S. Patent No. 6,483,539 and Bullock et al. fail to specifically disclose a controller adapted to set a connection flag in accordance with a detection result of said connection detector. However, Yamagishi teaches an information recording device, in which the recording-medium discrimination flag is set according to the result of the detection of connection of the memory card 11 to the connector 13 (figure 4, column 7, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Claim 9 of U.S. Patent No. 6,483,539 and Bullock et al. by the teaching of Yamagishi in order to let the operator recognize the status of the connection. This would let the user can select the desired mode for reading out an image pickup program.

As for claims 45-60, these claims are read on Patent Claims 10-25, respectively.

As for claim 61, Bullock et al. disclose a storage medium (RAM 124, Figure 2, Column 4, Lines 1-15) which computer-readably stores a program (program 152, 154, Column 4, Lines 1-15) to execute control of the image processing system.

5. Claims 62-63 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 45 of U.S. Patent No. 6,630,949.

Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons discussed below.

Application claim 62 is broader in scope, and the subject matter is encompassed by the patent claim 1.

Application claim 63 is broader in scope, and the subject matter is encompassed by the patent claim 45.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27, 29, 33-35 and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bullock et al. (US 5,675,358) in view of Yamagishi (US 5,857,059).

Regarding Claim 27, Bullock et al. disclose (Figures 1 and 2) an image processing system comprising an image pickup apparatus (118) including an image pickup unit (138); and an information processing apparatus (100) including an operating unit (132) adapted to enter information, a processor (130) adapted to process information entered at the operating unit, a display unit (114) adapted to perform a display corresponding to data processed by the processor, a memory unit adapted to store images (Column 8, Lines 27-31), and an interface adapted to detachably connect said image pickup apparatus (See Figure 2 and Column 3, Lines 3-7 and Column 2, Lines 66-67 and note that the image pickup apparatus is clearly detachable since the computer is an off-the-shelf item to which the image pickup apparatus as a peripheral device clearly must be connected using a detachable connection); a detector adapted to detect that the image pickup apparatus is connected (See Column 5, Lines 8-13 and note that a detection of

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whether or not the camera is connected is inherent in the decision to supply power thereto); and a controller adapted to switch between a mode for displaying sequential images sent from the image pickup apparatus on said display unit (Column 5, Lines 29-43), and a mode for displaying an image which was picked up by said image pickup unit and stored in the memory unit instead of the sequential images on said display unit (Bullock et al. disclose the stack buttons 183 and 184 determine all images displayed are to be stacked (stored). And a second global stacking function allows only "stacked" images are displayed (column 5, lines 1-29). Note that these "images" were picked up by the camera. It clearly that images, which were picked up by the camera, are stacked (stored) and displayed. When the camera 118 in Bullock is disconnected from computer 100 (Figure 1), there is no image transmitted from camera 118 to computer 100, therefore, only stacked images are displayed).

Bullock et al. fail to specifically disclose a controller adapted to set a connection flag in accordance with a detection result of said detector. However, Yamagishi teaches an information recording device, in which the recording-medium discrimination flag is set according to the result of the detection of connection of the memory card 11 to the connector 13 (figure 4, column 7, lines 63-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bullock et al. by the teaching of Yamagishi in order to let the operator recognize the status of the connection. This would let the user can select the desired mode for displaying image.

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Regarding Claim 29, Bullock et al. disclose that the display unit displays an image sent from the image pickup apparatus in a window in a display screen thereon (Column 5, Lines 29-43).

Regarding Claims 33-35, Bullock et al. disclose that the display unit displays a result detected by the detecting means as marks that relate to a camera and indicate an image pickup condition thereof (Column 5, Lines 29-43).

As to Claims 37-41 see Examiner's comments regarding Claims 27, 29 and 33-35, respectively.

Regarding claims 42-43, Bullock et al. disclose wherein said controller controls said display unit so as to display the image picked up by said image pickup apparatus, during an image pickup operation by said image pickup apparatus (Column 5, Lines 29-60) and display the image stored in said memory unit, during a cessation of the image pickup operation by the image pickup apparatus (images from the stack 206 may be displayed in several ways, Figures 12 and 13, Column 7, Lines 59-67).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Luong Nguyen** whose telephone number is **(703) 308-9297**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wendy Garber**, can be reach on **(703) 305-4929**.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231


or faxed to:

(703) 872 - 9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal drive,
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Technology Center 2600 Customer Service Office whose telephone
number is (703) 306-0377.

LN LN
11/30/2003


WENDY R. GARBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600